

**Remarks/Arguments**

Claims 1, 3-17 are pending in the application. Claim 1 is the sole independent claim.

Although it appears that the Examiner has intended for the Office Action of May 14, 2007 to be a final action, Applicants have noted that in the Office Action Summary both boxes for final and non-final actions were checked.

Applicants have also noted that the Examiner did not appear to consider dependent claims 16 and 17, which were added in the response of February 27, 2007. Consideration of these claims in the last office action may have clarified or addressed some of the issues and rejections made. It is therefore respectfully requested that the finality of the last office action be withdrawn should the present response not place the application in a condition for allowance so that these claims, or the limitations thereof, can be considered.

**I. Rejection Under 35 U.S.C. §112, First Paragraph**

Claims 1 and 3-15 were rejected under 35 U.S.C. §112, first paragraph, as being non-enabling for a “non-degradable” container. The Examiner states that while the specification is enabling for a reusable or refillable container, it does not reasonably provide enablement for “non-degradable” container.

Applicants respectfully disagree with the Examiner’s position and submit that the disclosure is enabling with respect to this limitation. It is clear from Applicants’ disclosure as originally filed what is meant by the term “non-degradable” such that the specification is enabling for this feature and its meaning.

Applicants would direct the Examiner to paragraph 0020 where the encapsulating or enclosing material for the chemicals to be released is described. These materials are described as being those that “degrade over a period of time to release said chemicals.” Accordingly, in this context, the container must necessarily be generally “non-degradable” in the production fluids in order to hold the chemicals encapsulated with such degradable enclosing materials to effectively provide release of the treatment chemicals. Those skilled in the art encountering the whole of Applicants’ specification will also readily understand

that the container is not made of such degradable materials that will degrade over a period of time during a single use, as does the encapsulating material. This is further supported by the fact that Applicants have described the container as being re-fillable or re-usable, as claimed in claim 16. And referring to paragraph 0018, it is described with respect to one particular embodiment that the container may be *permanently* anchored with the production tubing. Such permanence cannot be provided with a container that degrades in the production fluids.

Applicants recognize the Examiner's position that a refillable container may *gradually* degrade over time after several uses. *Emphasis added.* Applicants recognize that many materials may deteriorate over time and use. Such deterioration is not a design choice, however. Those skilled in the art when reviewing Applicants' disclosure will well recognize that in no way are Applicants intending for the container to degrade. Applicants have further amended claim 1 to specify that the container is generally non-degradable in the production fluids to provide further clarification of this. Applicants would again remind the Examiner that the subject matter of the claim need not have to be described *in haec verba* (i.e. using the same terms) in order for the disclosure to satisfy the description requirement. And it is clear from the term "degrade" as used in Applicants' specification that "non-degradable" with respect to the container must mean that the container does not degrade as do the encapsulating materials when exposed to the produced fluids, or as do the containers of Wald and Johnson et al., which by design are constructed to degrade or dissolve within the production fluids. Those skilled in the art would readily recognize and appreciate this from Applicants' disclosure and from the knowledge of the state of the art, which is evidenced by Wald and Johnson et al.

Applicants would again remind the Examiner that it is not necessary to enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment of the invention. See MPEP §2164, citing *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1338, 68 U.S.P.Q.2d 1940, 1944 (Fed. Cir. 2003). Moreover, detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention. See MPEP §2164. Moreover, the amount of guidance or direction needed to enable the

invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. MPEP§ 2164.03 citing *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. MPEP§ 2164.03.

For at least these reasons, Applicants respectfully submit that all the claims are enabled and the rejection of the claims on this basis should be withdrawn.

## **II. Rejections Under 35 U.S.C. §103(a)**

Claims 1 and 3-15 were rejected under 35 U.S.C. §103(a), as being obvious based upon Bruce (U.S. Patent No. 4,846,279), in view of Johnson (U.S. Patent No. 4,790,386). Claims 4, 6, 7 and 9 were rejected as being obvious based upon Bruce in view of Johnson, as applied above, and further in view of Burkhardt et al. (U.S. Patent No. 3,104,716). And claims 1 and 13-15 were rejected as being obvious based upon Moradi-Araghi (U.S. Patent No. 6,387,986) in view of Bruce and Johnson, as applied above.

None of the references cited and relied on by the Examiner provide a *prima facie* case of obviousness of the presently pending claims. In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim limitations when combined. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); and MPEP §2143.03.

Applicants' independent claim 1 calls for a "meshed- or mesh-like basket container through which produced fluids can flow without being significantly impeded." Contrary to the Examiner's position, Johnson does not provide any such meshed- or mesh-like basket container. Indeed, the container of Johnson provides nothing that can be construed as providing any such meshed- or mesh-like basket container since the container 22 is formed from cylinder walls 32 that prevent well fluids from coming into contact with the interior of the canister 22 (col. 4, lines 1-15).

The Examiner states that:

Johnson is teaching that an open mesh screen can be added to an opening of a container (such as the at least one aperture, which can be several, in the canister used in Bruce's method of treating a well bore), that can restrain any type of

treatment composition as, e.g., a solid, slow release chemical inhibitor composition, thereby providing an enhanced resultant method of treatment that can deliver various types of scale/corrosion inhibitor chemicals to the side walls of the production tubing of a well bore.

Applicants respectfully submit that the screen cover of Johnson, even when placed over the aperture or apertures of Bruce, as the Examiner suggests, does not provide anything whatsoever that can be construed as a “meshed- or mesh-like basket container through which produced fluids can flow without being significantly impeded.” The container of Johnson is not a basket but is formed from a continuous cylinder wall, in which in one particular embodiment, a mesh screen may optionally positioned over the top (col. 5, lines 21-27). Likewise, the container of Bruce is also not a meshed- or mesh-like basket container through which produced fluids can flow with being significantly impeded. Bruce also uses a cylindrical canister 22 that cannot be construed as being a meshed- or mesh-like basket container. Merely adding the screen mesh of Johnson over the aperture 34 of Bruce does not provide Applicants’ claimed meshed- or mesh-like basket container. Accordingly, for at least this reason, the combination of Bruce and Johnson fails in providing a *prima facie* case of obviousness because the references fail teach or suggest all of the claim limitations when combined. Claims 1 and 3-17 should therefore be allowed on this basis.

Additionally, even assuming that providing the screen of Johnson with the container of Bruce, as the Examiner suggests, can somehow be construed as providing a meshed- or mesh-like basket container, the resulting combination would still not allow produced fluids to flow through the container without being significantly impeded, as required in independent claim 1.

In response to Applicants’ prior arguments regarding this impeded flow, the Examiner states:

Bruce is expressly disclosing that the container can have several apertures through which the production fluids of the well can enter, thereby not “significantly” impeding the flow of production fluids through the container.

Applicants respectfully disagree with this statement. Bruce discloses a container that holds a liquid inhibitor that is carried within a bladder 30. The bladder 30 is connected

at one end to a capillary tube 38 having a restricted size (e.g. 1mm), which controls and restricts the flow rate of the fluids released from the bladder 30 (see col. 4, lines 32-59). Although Bruce may disclose that more than one aperture may be provided in the bottom of the canister, as the Examiner notes, the bladder 30 and capillary tube 38 itself prevents or “impedes” the flow of production fluids through the canister of Bruce. In Bruce, the fluids entering the bottom of the canister engage and compress the bladder. This increase in pressure compresses the bladder 30 and forces the liquids through the capillary tube 38. Fluids entering through the bottom aperture(s) would thus necessarily have to pass back out of the same apertures. There is nothing to indicate that the produced fluids can flow without being significantly impeded, as in Applicants’ claimed method.

Moreover, adding the mesh screen of Johnson to the canister of Bruce, as the Examiner suggests, does not change the configuration of Bruce to allow the flow of fluids unimpeded through the canister of Bruce. In order for fluids to flow through the canister of Bruce unimpeded, with or without the mesh screen of Johnson, at the very least one would be required to remove the bladder 30 and the capillary tube 38. Such drastic modifications would make the canister of Bruce wholly unsatisfactory for its intended purpose and destroy its function entirely. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P. §2143.01(V) citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

For this additional reason, the combination of Bruce and Johnson fails to provide a *prima facie* case of obviousness with respect to Applicants’ claims. Claims 1 and 3-17 should therefore be allowed for this additional reason.

Burkhardt was cited by the Examiner in combination with Bruce and Johnson in rejecting claims 4, 6, 7 and 9. Burkhardt also fails to disclose a meshed-or mesh-like basket container through which produced fluids can flow without being significantly impeded. Accordingly, the combination of Bruce, Johnson and Burkhardt fails in providing a *prima facie* case of obviousness with respect to claims 4, 6, 7 and 9. These claims should therefore be allowed over this cited combination.

In the response to Applicants' arguments, the Examiner also continued the rejection of claims 1 and 13-15 based upon Moradi-Araghi, in combination with Bruce and Johnson. Moradi-Araghi was merely cited by the Examiner as disclosing encapsulated crosslinking agents and gel-forming compositions to be used in oil-field applications. The Examiner recognized that Moradi-Araghi did not disclose a method for delivering the composition into a well bore. Accordingly, Moradi-Araghi also fails to provide a meshed-or mesh-like basket container through which produced fluids can flow without being significantly impeded. The combination of Bruce, Johnson and Moradi-Araghi thus fails in providing a *prima facie* case of obviousness with respect to claims 1 and 13-15. These claims should therefore be allowed over the cited combination.

### **III. Conclusion**

In light of the above remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

This response is being submitted within three months from the date of the office action. If any extension of time is believed necessary, however, such extension is hereby requested. The Commissioner is authorized to charge any additional required fee, or credit any excess fee paid, to Deposit Account 04-1579 (56.0719).

Respectfully submitted,



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